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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,507	09/21/2006	Peter Currie	36180/100472	1351
23644 7590 03/03/2009 BARNES & THORNBURG LLP P.O. BOX 2786 CHICAGO, IL 60690-2786				
EXAMINER				
SAJJADI, FEREDOUN GHOTB				
ART UNIT		PAPER NUMBER		
1633				
NOTIFICATION DATE		DELIVERY MODE		
03/03/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patent-ch@btlaw.com

Office Action Summary

Application No.

10/549,507

Applicant(s)

CURRIE ET AL.

Examiner

FEREYDOUN G. SAJJADI

Art Unit

1633

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-39 is/are pending in the application.
- 4a) Of the above claim(s) 22-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/16/2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/86)
- Paper No(s)/Mail Date 11/22/2005; 10/27/2006
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is in response to papers filed February 17, 2009. Applicant's responses to the restriction requirement of March 29, 2008 have been entered. No claims were amended, newly added or cancelled. Currently, claims 16-39 are pending in the application.

Election/Restrictions

Applicants' election of Group I (claims 16-21), drawn to an isolated zebrafish genetic strain having a dystrophin mutant phenotype form a mutation within the zebrafish dystrophin gene, is acknowledged. Applicants' species election of *sapje* (*sap*) *tm90c*, muscular dystrophy, addition to fish raising media, optical inspection of living tissue and chemical, is further acknowledged. Accordingly, claims 22-39, have been withdrawn from further consideration by the Examiner, pursuant to 37 CFR 1.142(b), as being drawn to non-elected inventions. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The election requirement is deemed proper and is therefore made **FINAL**.

Please note that after a final requirement for restriction, the Applicants, in addition to making any response due on the remainder of the action, may petition the Commissioner to review the requirement. Petition may be deferred until after final action on or allowance of claims to the invention elected, but must be filed not later than appeal. A petition will not be considered if reconsideration of the requirement was not requested. (See § 1.181.). The instant claims have been examined commensurate in scope of the elected invention and the species of the invention.

Elected claims 16-21 are under current examination.

Information Disclosure Statement

The information disclosure statements (IDS) submitted on November 22, 2005 and October 27, 2006 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the

information disclosure statements have been considered by the examiner, and indicated as such on Forms PTO PTO/SB/08A.

Objections to the Specification

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Further, an incorporation by reference by hyperlink or other form of browser executable code is not permitted. See 37 CFR 1.57(d) and MPEP § 608.01. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable codes on page 10, lines 29 and 30 of the specification. See MPEP § 608.01.

Objections to the Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02. The oath or declaration is defective because:

It was not executed in accordance with either 37 CFR 1.66 or 1.68.

It does not identify the citizenship of the first inventor.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Granato et al. (Development 123:399-413; 1996; of record).

The claims encompass an isolated zebrafish strain having a sapje tm90c mutant phenotype, that is a fish model for human muscular dystrophy.

Granato et al. teach large-scale genetic screen of zebrafish embryos, and identification of mutant genes controlling and mediating locomotion; the specific defects including muscle-specific degeneration (Title and Abstract). The isolation of zebrafish mutant embryos with defects in locomotion and somatic muscle, including sapje (sap) tm90c is set forth in Table 1, p. 402. The sap mutant is further disclosed as having degeneration restricted to somitic muscle segments (second column, and Fig. 3, p. 403).

With regard to the limitation of claims 20 and 21 for fish model of human muscular dystrophy, it should be noted that such is a characteristic inherent to the sapje tm90c mutant taught by Granato et al. As stated in MPEP 2112.01 II. "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Therefore by teaching all the limitations of the claims, Granato et al. anticipate the instant invention as claimed.

Conclusion

Claims 16-21 are not allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FEREYDOUN G. SAJJADI whose telephone number is (571)272-3311. The examiner can normally be reached on 6:30 AM-3:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach can be reached on (571) 272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fereydoun G Sajjadi/
Examiner, Art Unit 1633